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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/194,021	10/12/1999	JAMES RUDOLPH	8956.3	2708
7590 08/04/2005				
JOHN J CONNORS 1600 DOVE STREET SUITE 220 NEWPORT BEACH, CA 92660		EXAMINER MANAHAN, TODD E		
		ART UNIT PAPER NUMBER		
		3732		

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Pat

Office Action Summary	Application No. 09/194,021	Applicant(s) RUDOLPH, JAMES	
	Examiner Todd E. Manahan	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/25/00</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it is not on a separate. Correction is required. See MPEP § 608.01(b).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-29 are rejected under the judicially created doctrine of double patenting over claims 1-28 of U. S. Patent No. 6,142,155 because the claims of the patent "anticipate" the claims of the application. Accordingly, the application claims are not patentably distinct from the patent claims. Here, the more specific patent claims encompass the broader application claim. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 23-29 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 5,813,416 because the claims of the patent "anticipate" the claims

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of the application. Accordingly, the application claims are not patentably distinct from the patent claims. Here, the more specific patent claims encompass the broader application claim.

Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23, 25, 26, 28 and 29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mann (UK Patent No. 2,179,248).

Mann discloses a method comprising filing a nail with a file including a support member having an abrasive surface. A lubricant is placed on the abrasive surface, thus coating it, and comprises a germicide. Sufficient pressure is applied during filing to release the germicide such that the germicide contacts the nail being filed. Claim 26 recites the sanitizing agent being a germicide OR itraconazole, terbinafine, or fluconazole, thus Mann anticipates this claim by including a germicide. Regarding claim 29, the sanitizing agent is present in 1-100 percent of the mixture.

Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Piantedosi (United States Patent No. 5,419,014).

Piantedosi discloses an abrasive device comprising a plastic support member having an abrasive surface and a sanitizing agent coated thereon.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mann.

Mann discloses the claimed invention except for the germicide being dimethyl benzyl, ethyl benzyl, gasoline, or pine oil. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use dimethyl benzyl, ethyl benzyl, gasoline, or pine oil as the germicide, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 1-9 and 12-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oliver (United States Patent No. 5,779,519).

Oliver discloses a nail file comprising a support member coated with an abrasive material and fragrance filled microcapsule in the interstices between the abrasive particles so as to emit fragrance to the nail and into the ambient air during filing (see col. 2, lines 27-36). The fragrances may be fruit, plant, herbal or other scents occurring in nature (see co. 4, lines 32-35). Oliver discloses the claimed invention except for the fragrance being citrus fruit extract or pine oil. It would have been obvious to one having ordinary skill in the art at the time the invention

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was made to use either citrus fruit extract or pine oil as the fragrance, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. It is noted that citrus extract and pine oil have the inherent property of being sanitizing agents. Regarding claim 7, the abrasive particles may be of a size of 1 micron to 90 microns.

Claims 2, 3, 6-8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piantedosi.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use and oil based sanitizing agent, a citrus extract, a fungicide such as itraconazole, terbinafine, or fluconazole, or a germicide such as dimethyl benzyl, ethyl benzyl, gasoline, or pine oil, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Regarding claim 6, it would have been obvious to form the abrasive surface as granular abrasive particles instead of a molded abrasive surface, as such would amount to nothing more than substitution of functionally equivalent abrasive surface in the art.

Claims 5, 14, 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piantedosi as applied to claim 1 above, and further in view of Gordon et al. (United States Patent No. 3,472,675).

Piantedosi discloses the claimed invention except for the sanitizing agent being contained in micro-capsules. Gordon et al. discloses a cleaning pad having a cleansing or sanitizing agent contained in micro-capsules. It would have been obvious to one skilled in the art

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to micro-encapsulate the sanitizing agent of the device of Piantedosi in view of Gordon et al. in order that the sanitizing agent be only released when pressure is applied to the device thus rupturing the micro-capsules. Regarding claims 14 and 15, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the micro capsules either 12-50 microns in diameter or with a shell wall of 1/50-1/200 micron, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272- 4713. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan
Primary Examiner
Art Unit 3732

